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EXAMINER

NUTTER, NATHAN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte J. CHRISTOPHER MARMO

Appeal 2009-010061
Application 10/811,690
Technology Center 1700

Decided: June 3, 2010

Before ADRIENE LEPIANE HANLON, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 172-178 and 186. (Final Office Action ("Final"), mailed Dec. 5, 2007, 2), the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The Examiner maintains (Examiner's Answer ("Ans."), mailed Jul. 10, 2008, 4-7), and Appellant requests review of (Appeal Brief ("App. Br."), filed Jun. 3, 2008, 4), the following grounds of rejection:

1. claims 172-178 and 186 under 35 U.S.C. § 103(a) as unpatentable over Hu (US 2001/0044482 A1, pub. Nov. 22, 2001), Gordon (US 4,123,408, issued Oct. 31, 1978), or Shah (US 4,462,665, issued Jul. 31, 1984), each taken in view of Krezanoski (US 3,954,644, issued May 4, 1976); and

2. claims 172-178 and 186 under 35 U.S.C. § 103(a) as unpatentable over Tanaka (US 6,008,170, issued Dec. 28, 1999) or Salpekar (US 6,440,366 B1, issued Aug. 27, 2002), each taken in view of Krezanoski.¹

Claim 172, the sole independent claim, is directed to a package system which includes a hydrogel contact lens comprising a hydrophilic polymeric material and a water soluble polymer component ("WSPC") wherein the WSPC comprises a polyalkylene glycol.

According to the Specification, this contact lens is produced by polymerizing at least one hydrophilic monomeric component in the presence of a WSPC to form a contact lens body comprising a hydrophilic polymeric material and the WSPC. (Spec. 12:19-24.)

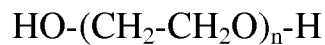
The Appellant discloses that the WSPC is physically immobilized by the hydrophilic polymeric material in the contact lens body. (Spec. 4:2-4.)

¹The Examiner has withdrawn the rejections of claims 172-178 and 186 under 35 U.S.C. § 103(a) as unpatentable over Hu, Gordon, or Shah each taken in view of Dziabo and as unpatentable over Tanaka or Salpekar each taken in view Dziabo. (Ans. 3.)

However, after placing the contact lens in the eye, the WSPC is at least partially replaced with water in the eye. (Spec. 9:24-29.)

The Appellant discloses that a useful class of WSPC's include polyethylene glycols. (Spec. 9:15-16.)

The Specification describes "polyalkylene glycols" as "polyethylene glycols, polypropylene glycols and the like" (Spec. 6:2-3) and specifically defines "polyethylene glycols" as "compounds that can be represented by the following formula:



wherein n represents a number such that the molecular weight of the polyethylene glycol is within the range of from about 300 to about 10,000 and preferably from about 400 to about 2000 or about 5000" (Spec. 9:16-22).

The Examiner's obviousness determination is based on findings that each of the primary references discloses a hydrogel contact lens as claimed. (*See* Final 2-3 and Ans. 4 (as to Hu, Gordon, and Shah) and Final 4 and Ans. 6 (as to Tanaka and Salpekar).) In the Appeal Brief, Appellant disagreed with these findings, contending that the references fail to disclose a contact lens comprising a polyalkylene glycol. (*See, e.g.*, App. Br., 15 (1st full para.) and 23.) In the Response to Argument section of the Answer, the Examiner, for the first time, explicitly identifies the paragraph relied on in each of Hu, Gordon, and Shah for a teaching of a polyalkylene glycol, i.e., polyethylene glycol. (Ans. 8.) With respect to Tanaka and Salpekar, the Examiner does nothing more than generally refer to columns within the references. (*See* Ans. 6; *see generally*, Ans. 7-9.)

In the Reply Brief, Appellant explains, in detail, why the relied upon paragraph in each of Hu, Gordon, and Shah, as well as the relied upon sections of Tanaka and Salpekar, fail to provide a teaching or suggestion of a contact lens comprising a polyalkylene glycol. (*See, e.g.*, Reply Brief (“Rep. Br.”), filed May 8, 2009, 3-4 (as to Hu), 4-5 (as to Gordon), 5 (as to Shah), 11-12 (as to Tanaka), 12 (as to Salpekar).)

Given the absence of contrary arguments or evidence from the Examiner, we find Appellant’s arguments persuasive in establishing that the Examiner’s findings are insufficient to support a *prima facie* case of obviousness as to the appealed claims. That is, on this record, the Examiner has not directed us to any portion of Hu, Gordon, Shah, Tanaka, or Salpekar that discloses or suggests a hydrogel contact lens comprising a hydrophilic polymeric material *and* a WSPC wherein the WSPC comprises a polyalkylene glycol.

Accordingly, we reverse both grounds of rejection.

REVERSED

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